



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/801,327	02/18/97	MULLER	1-20161/A/CO

IM61/0426
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EXAMINER
EINSMANN, M

ART UNIT	PAPER NUMBER
1751	

DATE MAILED: 04/26/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

(FR)

Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☐ Responsive to communication(s) filed on _____
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

- ☐ Claim(s) 2, 3, 5-12, 16-18 is/are pending in the application.
Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☐ Claim(s) 2, 3, 5-10, 16-18 **PLEASE TRANSMIT TO US IMMEDIATELY ART CITED ABROAD AND ADDITIONAL PERTINENT ART OF WHICH YOU ARE AWARE** is/are rejected.
- ☐ Claim(s) 11-14 is/are rejected.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____
 - ☐ received in this national stage application from the International Bureau (PCT Rule 22.1)

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) _____
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

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Part III DETAILED ACTION

Continued Prosecution Application

1. The request filed on March 23, 1999 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/801,327 is acceptable and a CPA has been established. An action on the CPA follows.

In a telephone conversation with Kevin Mansfield on April 22, 1999, this office was advised that no amendment is forthcoming at this time.

2. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same

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person or subject to an obligation of assignment to the same person.

3. Claims 2-3, ~~5~~-10, 16-18 are rejected under 35 U.S.C. § 103 as being unpatentable over Harms, GB 2,034,731.

Harms discloses water soluble reactive dyestuffs inclusive of applicant's dyestuff 1 when it contains the selected alkyl radicals as the B₁ aliphatic bridge member. Harms teaches that such bridge may be a straight or branch chain alkylene having 2-15 carbon atoms. See page 1 especially line 29 to page 2 line 5.

Harms differs from formula 1 in failing to exemplify the specific five and six carbon isomers as claimed herein.

The subject matter would have been obvious to the skilled artisan absent a showing of criticality because it is clear from the examples of bridge members exemplified in the disclosure from page 1 lines 32 to page 2 that five and six carbon alkyl isomers are preferred embodiments. Applicants' dyes containing isomers are equivalent to the isomers disclosed on pages 1 and 2 of Harms. Note that structurally similar compounds are generally expected to have similar properties. In re Gyurik, 596 F. 2d 1012, 201 USPQ 552. Closely related homologs, analogs and isomers in chemistry may create a prima facie case of obviousness. *In re Dillon* USPQ 2d 1897, 1904 (Fed. Cir. 1990); *In re Payne* 203 USPQ 245 (CCPA 1979); *In re Mills* 126 USPQ 513

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(CCPA 1960); *In re Henze* 85 USPQ 261 (CCPA 1950); *In re Hass* 60 USPQ 544 (CCPA 1944). The abstract discloses the utility for dyeing hydroxyl and nitrogen containing fiber materials.

This rejection is maintained as applied in the office actions of 03/05/96 and 11/19/96 in the parent application 08/541,009 for the reasons which follow.

4. Applicants have responded to this rejection by presenting a declaration by Dr. Bernhard Muller. The declaration under 37 CFR 1.132 filed 8/29/96 is insufficient to overcome the rejection of all the claims at issue based upon the insufficiency of the comparisons presented. Said declaration compares dyestuff 78 of GB-A-2,034,731, wherein B₁ is a three carbon alkyl component to applicants' claimed dyestuff where B₁ is a five carbon alkyl. Applicants claim three variations of B₁ which are five or six carbon isomers and one which is a three carbon alkyl chain substituted by a hydroxyl group. If applicants were to compare dye 78 of GB-A-2,034,731 with applicants' claimed B₁ component which is a three carbon chain substituted by hydroxyl and show unexpected results, that would be deemed to be a comparison of the closest art to that particular claimed component. The five and six carbon isomers are clearly favored by Harms for the bridge member, being listed on page 1 line 33 to page 2 line 2 no less than ten times. Examples 48 and 74 of Harms show five carbon alkyl groups exemplified as B₁ and example 59 exemplifies

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a six carbon alkyl isomer as B₁. Each should have been compared to all of the five and six carbon isomers used as the B₁ component in applicants' presently claimed dyestuffs. Since said alkyl chains are clearly disclosed by Harms, comparisons of each of the bridge members for which a patent is solicited must be made to the closest isomers in Harms' examples. The five member isomers must be compared to five member isomers; the six member isomers to six member isomers for it to be a true comparison of the closest art.

Claims 11-12 are allowable over the prior art of record.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for response to this final action is set to expire THREE MONTHS from the date of this action. In the event a first response is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory

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period for response expire later than SIX MONTHS from the date of this final action.

****Applicant is advised to note the new art unit number and refer to the new number in any further communications regarding this application****

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret Einsmann whose telephone number is (703) 308-3826. The examiner can normally be reached on Monday to Thursday and alternate Fridays from 7:00 A.M. to 4:30 P.M.

The fax phone number for this Technology Sector is (703) 305-3599

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Sector receptionist whose telephone number is (703) 308-0661.



MARGARET EINSMANN
PRIMARY EXAMINER 1751

April 26, 1999